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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,106	04/13/2001	Dan A. Steinberg	ACT.008	4209
110	7590 03/18/2004	•	EXAMINER	
DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET			ZARROLI, MICHAEL C	
SUITE 2400	I SIREEI		ART UNIT	PAPER NUMBER
PHILADELPHIA, PA 19103-2307			2839	
			DATE MAILED: 03/18/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
0.65	09/835,106	STEINBERG ET AL.	
Office Action Summary	Examiner	Art Unit	
	Michael C. Zarroli	2839	_
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address	
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period we Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	within the statutory minimum of thirty (30) days ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on 06 No	ovember 2003.		
·— · · · · · · <u> </u>	action is non-final.		
3) Since this application is in condition for allowant closed in accordance with the practice under E			
Disposition of Claims			
4) ☐ Claim(s) 1-3,5,6 and 8-43 is/are pending in the 4a) Of the above claim(s) is/are withdraw 5) ☐ Claim(s) 1-3,5,6,8-27 and 34 is/are allowed. 6) ☐ Claim(s) 28,31,35,37,39,42 and 43 is/are reject 7) ☐ Claim(s) 29,30,32,33,36,38,40 and 41 is/are ob 8) ☐ Claim(s) are subject to restriction and/or	vn from consideration. ted. sjected to.		
Application Papers			
9)☐ The specification is objected to by the Examiner 10)☐ The drawing(s) filed on is/are: a)☐ acce		Evaminer	
Applicant may not request that any objection to the			
Replacement drawing sheet(s) including the correcti			
11)☐ The oath or declaration is objected to by the Ex			
Priority under 35 U.S.C. § 119			
 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list of 	s have been received. s have been received in Applicati ity documents have been receive ı (PCT Rule 17.2(a)).	on No ed in this National Stage	
Attachment(s)	" 	(770 440)	
Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summary Paper No(s)/Mail Da		
 2) Notice of Draisperson's Patent Drawing Review (PTO-946) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>numerous</u>. 		Patent Application (PTO-152)	

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1. New grounds of rejection have necessitated this first action nonfinal after filing of an RCE.

Claim Objections

2. Claim 29 objected to because of the following informalities: Misspelling of An. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 28 and 31 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shigematsu et al (US 5185825).

Shigematsu discloses an optical switch (title), comprising: a substrate (41) having at least one longitudinal groove and at least one transverse groove (unnumbered figures 3a & 3b); a first waveguide holding member (21) having at least one transverse groove (23); and a second waveguide holding member (22) having at least one longitudinal groove (34).

Regarding claim 31 Shigematsu discloses that said substrate further includes at least one pit (figures 3a & 3b unnumbered).

Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 6. Claims 35, 37, 39 and, 42-43 rejected under 35 U.S.C. 103(a) as being unpatentable over You et al (US 6160936).

You discloses a first waveguide holding member (110) and a second waveguide holding member (120) disposed over a substrate (100), said first waveguide holding member being movable relative to said substrate; and at least one movement guiding member (fig. 1) disposed between said substrate and said first waveguide holding member to guide the motion of said first waveguide holding member relative to said second waveguide holding member (claim 1 lines 50-53), said movement guiding member comprising at least one depression (124) and at least one positioning member (102) disposed in said depression.

You does not disclose that this structure is intended for use as an optical switch.

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However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to employ the optical waveguide aligner/connector of You et al as an optical switch. The motivation/suggestion for doing so would have been utilize the invention of You et al as an on/off switch; alignment of the first and second waveguide transmits an optical signal and then a loss of signal when the first waveguide is slid out of focus from the second waveguide.

In addition, the examiner calls attention to MPEP 2111.02. Where the discussion is that a preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. In re Hiro, 535 F. 2d 67, 190 USPQ 15 (CCPA 1976), Kropa v. Robie, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 37 You discloses that said movement guiding member is configured to permit said first waveguide holding member to move longitudinally relative to said second waveguide holding member (fig. 1).

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Regarding claim 39 You discloses that the at least one is disposed in said first waveguide holding member (112 or 124 in fig. 1).

Regarding claim 42 You does not disclose that the substrate and at least one of the waveguide holding members are comprised of a monocrystaline material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form these components out of a monocrystaline material, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S.164. The motivation for this material would be its noted strength characteristics.

Regarding claim 43 You discloses (fig. 1) that at least one movement guiding member disposed between said substrate and said second waveguide holding member to guide the motion of said second waveguide holding member relative to said first waveguide holding member, said movement guiding member comprising at least one depression (120) and at least one positioning member (102) disposed therein.

Allowable Subject Matter

7. Claims 1-3, 5-6, 8-27 and, 34 allowed.

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8. Claims 29-30, 32-33, 36, 38 and, 40-41 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Reasons for allowance were given in previous office actions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Zarroli whose telephone number is 571-272-2101. The examiner can normally be reached on 7:30 to 3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Feild can be reached on (571) 272-2800 ext 39. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Zarroli Primary Examiner Art Unit 2839

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